REMARKS

Claims 23 and 24 are pending. Claims 23 and 24 are amended. The basis for these amendments can be found, for example, at page 6, line 25 to page 7, line 1 of the filed application.

The Office Action objects to the use of the "derives from" and "claims priority to" language in the claim to priority in the first paragraph of the application. This objection is believed to be moot in view of the amendments to the paragraph.

The Examiner has required Applicants to delete the amendment to the specification filed on January 10, 2002. Applicants believe that this date is in error. Our December 4, 2001 response (stamped January 10, 2002 by the Patent Office), did not contain an amendment to the specification. Applicants believe that the Examiner intended to refer to our April 2, 2003 amendment to the specification which concerns subject matter related to the new matter allegations. Applicants, however, traverse this requirement. The Office Action states that the incorporation by reference statement in the specification does not "direct particular attention to the specific portions of the referenced document where the subject matter being incorporated may be found" (Office Action at page 6). Applicants note, however, that the incorporation by reference statement, which was contained in the original filing, is specific to the "structure and synthesis of PNAs" (page 3, lines 2-4 of the application). Because the statement and amendment both are directed to PNA structure, the entry is specific as required by M.P.E.P. § 608.01(p). Reconsideration and withdrawal of the rejection is requested.

Claims 23 and 24 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. Claims 23 and 24 are amended. Independent claims 23 and 24 read substantially on originally filed dependent claims 23 and 24. As such, the rejection based on allegedly new matter is believed to be moot.

Claims 23 and 24 stand rejected under the judicially created doctrine of obviousness-type double patenting doctrine as allegedly being patentably indistinct from the structure of claim 1 of U.S. Patent No. 5,773,571 (the 571 patent). Compounds according to claims 23 and 24 differ from those according to claim 1 of the 571 patent in at least the linking moiety "A" that connects "L" to "J". In instant claims 23 and 24, for example, the linking moiety is

-$C(O)CH_2$-. In the 571 patent claim, as admitted by the Examiner (page 8 of the Office Action), only formula IIb could arguably provide such a linking moiety. The 571 patent, however, further requires that compositions having formula IIb linkers have either "at least one A group of formula (IIc)" or that "at least one of y or z is not 1 or 2." Each of these limitations places the claims in the 571 patent outside the instant claims. Claims 23 and 24, for example, are not directed to compounds that include a linker of formula IIc, or have a structure where "y" or "z" from claim 1 of the 571 patent are not "1" and "2." The Office Action states that there is apparently no "y" or "z" in claim 1 of the 571 patent. The variable "y" can be found, however, in the T^1-T^n definition. The variable "z" should appear in the definition of D^1-D^n which should read in part "$(CR^6R^7)_z$." This definition was the subject of a Certificate of Correction issued on October 24, 2000. In addition to the Certificate of Correction, see, for example, column 3, lines 45-48 of the 571 patent. Based on at least these differences, Applicants submit that the instant claims would not have been obvious in view of claim 1 of the 571 patent. Reconsideration and withdrawal of the rejection is, therefore, respectfully requested.

Further, instant claim 24 is directed to a peptide nucleic acid incorporated into a liposome. Claim 1 of the 571 application does not disclose a compound incorporated in a liposome. For at least this reason, Applicants believe that the rejection, as applied to claim 24, should be withdrawn.

Applicants further note that at no time during prosecution has any art has been cited against the instant claims under 35 U.S.C. §§ 102 or 103. Based on this fact, and the arguments and amendments presented herein, Applicants submit that all of the claims presently before the Examiner patentably define the invention over the prior art and are otherwise in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,

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